

REMARKS

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request entry of the amendment and reconsideration of the claims in view of the remarks presented below.

Claims 19-23 have been withdrawn. Thus, claims 1-18 are pending in the application.

Claims 1-18 were rejected under 35 U.S.C. 102(b) as being anticipated by Tomkow (International Pub. No. WO 01/10090). Applicant respectfully traverses this rejection.

It is axiomatic that, to anticipate a claim, a reference must disclose each and every element or step of the claim. Also axiomatic is that the claim must be read as a whole, that is, each claim element and limitation, as set forth in the claim, must be found in the cited reference. Applicant respectfully submits that this is not the case here.

The Examiner has either misread Tomkow, the cited reference, Applicant's pending claims, or both. For example, to reject the claim term "adding a pixel to the message at the server, the pixel capable of being altered to indicate that the message has been opened by a recipient" the Examiner cites to page 13, line 19 to page 14, line 31 of Tomkow. The cited section is titled "MUA NOTICES (READING NOTIFICATIONS)" and describes the operation of a MUA. This section defines MUA notices as:

[E]mails that are sent to the (nominal) author of a message by the recipient's Mail User Agent (MUA)(e-mail program) when certain events occur: e.g. the message is opened for reading, or deleted from the system without being read. By internet convention (RFC 1891), no MUA program can be forced to generate such notifications. Whether an MUA will generate these receipts will depend upon the configuration chosen by its user. (emphasis added).

Tomkow goes on to state:

The RPost server 14 will configure and transmit messages in a way that attempts to elicit both MTA DSNs and MUA notices from compliant MTAs and MUAs. In order to elicit a Reading Receipt from compliant MUAs, certain headers must be included in the header section of an e-mail message. Different MUAs respond to different header; hence Server 14 will add several different headers to each message requesting a read notification in a form recognized

by various MUAs. These headers all take the form: Header label:
user name <user address>.

For example: Disposition-notification-to: john smith
jsmith@adomain.com; read-notification-t0: john smith
jsmith@adomain.com

Where 'john smith' is the name of the user to whom an MUA notification is to be sent and '<jsmith@adomain.com>' is that user's Internet address. Normally such headers would refer to the author of the message but in the case of the present method it is required that the notification be returned to RPost so that the notification can be processed by RPost. To assure that this is so Server 14 will insert headers that request that MUA receipts be sent to an address where they can be processed by the RPost server, for example, "readreceipt@RPost.com." This will direct any compliant recipient MUAs to send their notifications to an RPost address for processing. (emphasis added).

It is clear from the above quoted text that Tomkow does not teach, or even suggest, adding, at a server, a pixel that is capable of being altered to indicate that the message has been opened to the message before the message is sent to a recipient, as is claimed in amended claim 1. As recited by claim 1, the message, including the pixel, is then sent to the recipient, where, when the message is opened, the pixel is altered to indicate the opening of the message, and then the message and the altered pixel is transmitted back to the server for further processing before the message and altered pixel are sent to the sender of the message.

In contrast, Tomkow (see above quoted text) only teaches adding a header to a message, where the header includes an instruction to a MUA to send a read notification back to a specified address. Tomkow's header does not change when the message is opened. Moreover, Tomkow's header will only elicit a response from a compliant MUA; if the MUA is not compliant with the header request, or has been instructed to ignore header requests, no response can be elicited.

A further distinction is that a compliant MUA creates the email that it returns to the address indicated in the header. (*See* Tomkow, page 13, lines 20-25). This is not the same as is claimed in Applicant's claim 1, where a pixel is added to the message at the server, and the pixel is altered when the message is opened, and the message with the altered pixel is sent back to the server. No new email is created when the pixel is altered.

According to claim 1, the mere opening of the message by the recipient causes the pixel to be altered and the message and altered pixel sent back to the server. The claimed invention causes the pixel to be altered and the message and altered pixel sent back to the server even if the recipient's MUA is not configured to provide a read receipt. Thus, the invention of claim 1 ensures that an indication of whether the message has been opened by a recipient is provided to a sender even if the recipient's email client does not otherwise provide such an indication.

Claim 7 was amended similarly to claim 1 to recite that the message contains an alterable pixel that is altered to indicate that the message has been opened when the message is opened by a recipient, and that the message and the indication that the message has been opened is transmitted back to the server for further processing before it is forwarded to the sender. As stated above, Tomkow neither teaches nor suggests transmitting a message with such an alterable pixel, nor altering the pixel to indicate that the message has been opened by the recipient when the message is opened.

Claim 13 was also amended similarly to claims 1 and 7. As amended, claim 13 recites that a pixel capable of being altered to indicate that a message has been opened by a recipient is added to a message at a server before the message and alterable pixel are sent to the recipient. Amended claim 13 also recites altering the pixel when the message is opened by the recipient and transmitting the message and altered pixel from the recipient to the server. As stated previously, Tomkow neither teaches nor suggests transmitting a message with such an alterable pixel, nor altering the pixel to indicate that the message has been opened by the recipient when the message is opened.

Applicant also respectfully submits that amended claims 1, 7 and 13 are not obvious in view of Tomkow. Tomkow only discloses the use of emails created by a recipient's MUA as notifications that a message has been opened. Such messages are generated by the recipient's MUA, and do not include a copy of the original message. Tomkow teaches adding headers to a message to ensure that the MUA notifications are directed to an RPost server, where the MUA notification is matched to the original message.

In contrast to the teachings of Tomkow, amended claims 1, 7 and 13 all teach sending a message having an alterable pixel to a recipient. When the recipient opens the message, the pixel is altered to indicate that the message has been opened, and then the message, and the altered

pixel, are sent back to the server. Thus, the indication that the message has been opened and the message do not need to be matched at the server when the indication that the message has been opened is received by the server, as must occur when using the system disclosed by Tomkow. This eliminates the possibility of mismatching the message and the indication that the message has been opened. Moreover, using the methods claimed in amended claims 1, 7, and 13, the server can provide the sender with an indication that the message has been opened even if the recipient's MUA is not configured to provide such notifications. Tomkow does not provide solutions to these problems, nor would the solution provided by the methods of the amended claims be ascertainable from Tomkow by one skilled in the art.

For all of the reasons above, Applicant respectfully submits that amended claims 1, 7, and 13, and their dependent claims, are patentable over the cited art and respectfully request that the rejections be withdrawn and that claims 1-18 be allowed.

CONCLUSION

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented. In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Should the Examiner have any questions concerning the above amendments and arguments, or any suggestions for further amending the claims to obtain allowance, Applicants request that the Examiner contact Applicants' attorney, John Fitzgerald, at 310-242-2667.

The Commissioner is authorized to credit any overpayment or charge any additional fees in this matter to our Deposit Account No. 06-2425.

Date: November 4, 2009

Respectfully submitted,

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